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EXAMINER

BARQADLE, YASIN M

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEVIN F. BERNIER, RICHARD A. PINEAU, and TODD
LYNTON

Appeal 2009-004673
Application 10/023,245
Technology Center 2400

Decided: June 30, 2010

Before JOSEPH F. RUGGIERO, CARLA M. KRIVAK, and BRADLEY W.
BAUMEISTER, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-24, which are all of the pending claims. Claims 25-30 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Rather than reiterate the arguments of Appellants and the Examiner, we refer to the Appeal Brief (filed January 31, 2008), the Answer (mailed April 29, 2008), and the Reply Brief (filed June 30, 2008) for the respective details. We have considered in this decision only those arguments Appellants actually raised in the Briefs. Any other arguments which Appellants could have made but chose not to make in the Briefs are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellants' Invention

Appellants' invention relates to the providing of a permanent record, at the location of a user chosen remote printer, of a rendered service. Before the generation of the permanent record, data necessary to provide the service and the data required for the service are processed by at least one remote server. (*See generally* Spec. 3:4-16).

Claim 1 further illustrates the invention and reads as follows:

1. A method of providing a service and generating, at the location of a user chosen and designated remote printer, a permanent record of said service, wherein, before generating the permanent record, data necessary to provide said service and data necessary to provide said permanent record are processed by at least one remote server operated by a server provider, said method comprising the steps of:

receiving over a data communications network at a remote service provider receiving center, from a user operated communications device, a request for the service and said data necessary to provide the service including user provided data identifying and specifying said user chosen

remote printer and data regarding how to address and access said remote printer over a data communications network, said receiving center comprising at least one service provider operated remote server; said data necessary to provide the service being processed to generate data required for the service;

processing on said service provider operated remote server said data required for the service and other stored data to generate input data for a specific and identified user chosen and designated remote printer; and

transmitting by said service provider over a data communication network to said specific user designated remote printer said input data, said input being rendered by the specific printer as the permanent record of said service.

The Examiner's Rejections

The Examiner's Answer cites the following prior art references:

Kemp	US 2002/0078160 A1	Jun. 20, 2002 (filed Dec. 15, 2000)
Sehr	US 2002/0100802 A1	Aug. 1, 2002 (filed Mar. 1, 2002)
Smith II (Smith)	US 2002/0113994 A1	Aug. 22, 2002 (filed Oct. 22, 2001)

Claims 1-10, 13-18, and 21-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kemp in view of Smith.

Claims 11, 12, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kemp in view of Smith and Sehr.

ISSUE

Based on Appellants' contentions, as well as the findings and conclusions of the Examiner, the pivotal issue before us is whether the Examiner erred in concluding that it would have been obvious to an ordinarily skilled artisan to combine the teachings of Smith and Kemp, thereby resulting in the invention as claimed.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

1. Kemp discloses (Fig. 1; ¶ [0035]) a system for printing over the Internet in which a client user 1 submits a print job to a service provider 2 “where the print job is processed and printed according the user’s request.”
2. Kemp further discloses (Fig. 6B; ¶ [0057]) a display window enabling a user to select the option 63 to print to remote service providers.
3. Also disclosed by Kemp (¶ [0073]) is the configuration of the remote server “to automatically process the print job data upon receipt and manual operator intervention would not be required.”
4. Smith discloses the use of a portable device (PDA 119) to select the printing of a full-length version of displayed information at a remotely connected printer 115. By selecting appropriate inputs on the portable device a user can “access versatile printing options that allow any time and anywhere printing of full length information.” (Smith, Figs. 1 and 5; ¶ [0030]).

5. Smith further discloses (Fig. 7 D; ¶¶ [0033] and [0037]) that the portable user device prints by transferring print information to a printer over the Web providing the user with a wide range of variable print options.

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (stating that 35 U.S.C. § 103 leads to three basic factual inquiries: the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art). Furthermore,

‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

Claims 1-10, 13-18, and 21-24

With respect to the Examiner’s 35 U.S.C. § 103(a) rejection of each of the appealed independent claims 1 and 15, Appellants’ arguments focus on the contention that the Examiner has not provided a proper basis for the

proposed combination of Kemp and Smith. According to Appellants (App. Br. 7-11; Reply Br. 2-3), Smith, which discloses a number of pathways to direct printing to a user's own printer, does not make up for the deficiencies of Kemp, which requires that an operator at a remote server select a particular printer for a particular printing operation. In Appellants' view (*id.*), the Examiner has not provided a valid reason for combining Kemp and Smith and, even if combined, the resulting combination would not suggest the printing of a permanent record of a transaction at a user designated remote printer as claimed.

We do not agree with Appellants. We find that the Examiner has provided a valid articulated line of reasoning with a rational underpinning to support the legal conclusion of obviousness. We agree with the Examiner (Ans. 6 and 12-14) that both Kemp and Smith are directed to the remote printing of a permanent record, e.g., a job ticket, of a transaction. (FF 1-4) Further, we agree with the Examiner that Smith adds versatility to the system of Kemp by providing "any time and anywhere printing of full length information" by enabling various user selectable options for selecting a remote printer. (FF 4 and 5) Also, regardless of whether we might agree with Appellants' contention (Appeal Br. 9; Reply Br. 2) that all of the printing pathways in Smith lead back to a user's own printer, we find nothing in the claim language that would preclude a printer that is in a user's ownership domain, but physically remote from the user's portable input communication device, from being a remote printer as claimed.

Lastly, while we find no error in the Examiner's proposed combination of Smith with Kemp as previously discussed, we note that, contrary to Appellants' arguments (App. Br. 8; Reply Br. 2-3), Kemp's

disclosure is not limited to requiring an operator at the remote server to select a printer. As described by Kemp (FF 3), the remote server could be configured “to automatically process the print job data upon receipt and manual operator intervention would not be required.” Accordingly, we fail to see why the automatic selection of a printer by a user selected remote server would not correspond to a user chosen remote printer as claimed.

For the above reasons, we sustain the Examiner’s 35 U.S.C. § 103(a) rejection of independent claims 1 and 15, as well as dependent claims 2-10, 13, 14, 16-18, and 21-24 not separately argued by Appellants.

Claims 11, 12, 19, and 20

We also sustain the Examiner’s obviousness rejection of dependent claims 11, 12, 19, and 20. We find no error in the Examiner’s application (Ans. 9-10) of the event ticket teachings of Sehr to the combination of Kemp and Smith. Appellants’ arguments (App. Br. 11) rely on those asserted against the obviousness rejection of independent claims 1 and 15. We find those arguments to be unpersuasive as discussed *supra*.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1-24 for obviousness under 35 U.S.C. § 103(a).

DECISION

We affirm the Examiner's decision rejecting claims 1-24 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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